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Patent

Attorney Docket No: IMG-00112.P.1-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)

Sujay Singh and)
Peter Dias)

Examiner: Wilson, Michael C.

Application Number: 09/884,579)

Group Art Unit: 1632

Filed: June 18, 2001)

For: TRANSGENIC AVIAN SPECIES)
FOR MAKING HUMAN AND)
CHIMERIC ANTIBODIES)

Assistant Commissioner for Patents
Washington D.C., 20231

Sir,

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed November 14, 2002, Applicants submit the following election and traverse. Applicants submit this response within four months of that mailing date. A fee of \$725.00 for Extension for response within the fourth month is enclosed.

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I. ELECTION

Applicants elect the invention of Group III, reciting a method of making an antibody using a transgenic bird. This election is made with traverse.

The above-identified patent application has been examined for restriction purposes only. The Examiner has set forth the following 6 Groups:

Group Number(s)	Claims	Subject Matter
I	1, 6, and 11	A transgenic bird having a knockout of an endogenous immunoglobulin gene
II	2-5, and 7-10	A transgenic bird having a knockout of an endogenous immunoglobulin gene and an insertion of an exogenous immunoglobulin gene
III	12 and 16	A method of making an antibody using a transgenic bird
IV	13, 15, 17, 19, and 22	An antibody
V	14, and 18	A method of making an antibody using a transgenic bird
VI	20 and 21	Transfecting cells with DNA encoding an antibody

In the Office Action, the Examiner restricts the claims to Six distinct and independent inventions. For the following reasons, Applicants traverse this restriction requirement.

A. Standard for Restriction

The M.P.E.P. (Feb. 2000) sets forth the standard for restriction requirements.

There are two criteria for a proper requirement for restriction between patentably distinct intentions:

- A. The inventions must be independent (see M.P.E.P. §802.01, §806.04, §808.01) or distinct as claimed (see M.P.E.P. §806.05 - §806.05(i); and
 - B. There must be a serious burden to the examiner if restriction is not required (see M.P.E.P. §803.02, §806.04(a) - (j), §808.01(a) and §808.02)
- M.P.E.P. § 803 (Feb. 2000)

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not useable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

M.P.E.P. § 802.01 (Feb. 2000).

B. The Claims

Claims of Group II, Group III, and Group V as set forth in the application, while being patentably distinct, do not require restriction as they are connected by a single, searchable unifying relationship that connects the claims in design. M.P.E.P. § 802.01 (Feb. 2000). Because of the single, searchable unifying relationship, the Examiner would not be seriously burdened by searching and examining the claims together in a single application.

The claims are connected by a single searchable unifying relationship, namely a transgenic bird having a knockout of an endogenous immunoglobulin gene and an insertion of an exogenous immunoglobulin gene and methods of making an antibody using said bird. This unifying relationship connects the claims of the groups in design because all claims relate to the same transgenic bird. The single searchable unifying element can be primarily searched by electronically searching key words.

Because the claims as set forth in the application are patentably distinct, are not independent and are connected by a single searchable unifying element, the Examiner would not be seriously burdened by examining these claims together. Accordingly, Applicants request that the Examiner join the claims of Groups II, III, and IV. In the alternative, Applicants request that the Examiner join the claims of Groups II and III. Also, Applicants respectfully note that the claims of Group III and Group V refer to the claims of Group II, thus a search of the claims of Group III would include a search of the claims of Group II and Group V. Accordingly, the USPTO would not be unduly burdened to search and examine the claims of Groups II, III, and V together.


III. CONCLUSION

Applicants elect the invention of Group III, however, based on the commonality of the subject matter, Applicants request that the Examiner join the pending claims of Groups II, III, and V into a single group or alternatively join the pending claims of Groups II and III. Applicants respectfully submit that the claims are ready for examination and in condition for allowance.

Please apply any charges not covered, or any credits, to **Deposit Account Number 501321** in the name of David R. Preston & Associates, having **Customer Number 24232**.

Date: April 7, 2003

Respectfully submitted,



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